

REMARKS

Claims 1-20 are pending in this application. By this Amendment, claims 1 and 8 are amended to even more clearly distinguish from the cited reference and claims 9, 19 and 20 are amended for clarity. Support for the amendment of claims 1 and 8 can be found in Applicants' specification, for example, at page 3, lines 27-28.

Applicants note with appreciation the identification of allowable subject matter in claims 4 and 11. Applicants submit that all pending claims are in condition for allowance as detailed below.

Claims 1-3, 5, 8-10, 12 and 17-20 stand rejected under 35 U.S.C. §102(e) over Hull (U.S. Patent No. 6,671,684). The rejection is respectfully traversed.

Hull fails to disclose each and every feature recited in independent claims 1 and 8. In particular, Hull fails to disclose "a processing device for detecting annotations...the annotations identifying lesser portions of text to be extracted from machine generated text of the original image of the document...extracting only the lesser portions of text from the machine generated text from the original image of the document identified by the detected annotations" and "a summary generator for generating a summary including only the extracted lesser portions of text from the machine generated text of the document, the summary being a condensed version of the machine generated text of the original image of the document and being generated as a separate electronic image document that is different from the original image", and "an image output device coupled to the summary generator and that outputs the summary for review by a user, the image output device being one of a display screen and a printer" as recited in independent claim 1, and similarly recited as a method in independent claim 8.

In rejecting Applicants' claims, the Office Action alleges that Hull generates a summary that includes only the extracted lesser portions of the text from the machine

generated text of the document. See Office Action page 4. However, Hull discloses a method and apparatus for simultaneously highlighting a paper document and an electronic version of the document. See Abstract. Hull processes the highlighted text then conducts a query to locate documents in a document database 706 containing the highlighted portions of the document. See column 3, line 60 through column 4, line 38 and Figure 2. Hull does not disclose "a summary generator for generating a summary" as recited in independent claim 1 and similarly recited in independent claim 8.

Hull does not output the alleged summary (the highlighted text). Hull does not suggest outputting the highlighted text via a screen or printer and discloses no reason to do so. Rather, the highlighted text is used as a query to identify one or more documents containing the highlighted text. See paragraph [0023] and Fig. 1. The highlighted text is never output to a user via a screen or printer. Thus, claims 1 and 8 are patentable. Accordingly, claims 2, 3, 5, 9-10, 12 and 17-20 also are patentable by their dependence on claims 1 and 8 for at least the reasons explained above regarding claims 1 and 8. Withdrawal of the rejection is respectfully requested.

Claims 6 and 13 stand rejected under 35 U.S.C. §103(a) over Hull. Claims 6 and 13 are patentable by their dependence on claims 1 and 8 for at least the reasons explained above regarding claims 1 and 8. Withdrawal of the rejection is respectfully requested.

Claims 7 and 15-16 stand rejected under 35 U.S.C. §103(a) over Hull in view of Bornstein (U.S. Patent No. 6,751,779). Bornstein fails to overcome the deficiencies of Hull explained above regarding claims 1 and 8. Accordingly, claims 7 and 15-16 are patentable by their dependence on claims 1 and 8 for at least the reasons above regarding claims 1 and 8. Withdrawal of the rejection is respectfully requested.

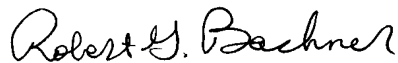
Claim 14 stands rejected under 35 U.S.C. §103(a) over Hull in view of Kupiec (U.S. Patent No. 6,533,822). Kupiec fails to overcome the deficiencies of Hull explained above

regarding claim 8. Thus, claim 14 is patentable by its dependence on claim 8 for at least the reasons explained above regarding claim 8. Withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Robert G. Bachner
Registration No. 60,122

JAO:RGB/jls

Date: May 18, 2009

OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>
--